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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,889	06/25/2003	Hiroki Kobayashi	R2184.0239/P239	2305
24998 7590 03/20/2008 DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403				
EXAMINER NEWAY, SAMUEL G				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/602,889

**Applicant(s)**

KOBAYASHI, HIROKI

**Examiner**

Samuel G. Neway

**Art Unit**

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-6, 14 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-6, 14 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This is in response to the RCE filed on 07 February 2008.
2. Claims 1 – 3, 7 – 9, and 15 – 17 have been cancelled. Claims 4 – 6, 14, and 18 are pending and are considered below.

### ***Response to Amendment***

3. The rejections of claims 6 under 35 U.S.C § 101 in the last Office Action have been withdrawn in view of Applicant's amendments.

### ***Response to Arguments***

4. Applicant's arguments filed on 07 February 2008 have been fully considered but they are not persuasive.

Applicant argues that Machida fails to disclose reading a template to determine whether it contains one or more parameters representing incomplete information. The Examiner respectfully disagrees. Machida discloses determining whether to acquire property information (data to be included in driver) of a driver (template with parameters, see Fig. 3 and related text) ([Fig. 7, step s601 and related text]). The property information is not acquired if it is already included in the driver.

Applicant also argues that Machida fails to disclose incorporating acquired data into the parameters of the template and inputting the produced scenario to an installation program. However, Machida discloses updating the driver (template with parameters) by including the property information (acquired data) ("update the driver in

accordance with the acquired property information", [0073] and FIG. 7, step s607). Furthermore, installation is inherent in updating of the driver which is saved, i.e. installed, after the property information has been added.

In response to applicant's arguments, the recitation "method for installing a plurality of items of software ... and simultaneously performing initial print setup" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

### ***Claim Objections***

5. Claim 14 is objected to because of the following informalities: it is believed that "the template being a file describing procedures for installing software" should be 'the scenario being a file describing procedures for installing software' as is stated in claims 4 – 6 and 18.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim recites "said acquiring step includes" in line 11. It is unclear if this is directed to the "acquiring a template" of line 4 or "acquiring data" of line 7. It is believed the limitation should be 'said acquiring data step includes' and is treated as such below.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 4 – 6, 14, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Machida (US PGPub 2002/0083131).

Claim 4:

Machida discloses a software-installing method for installing a plurality of items of software in a computer and simultaneously performing initial print setup in a computer, so as to use one of a plurality of printing devices connected the computer through a network (see [0004] and [0012]), the method comprising the steps of:

acquiring a template (driver for which property information is requested) of a scenario, the scenario (driver including property information) being a file describing procedures for installing the software ([0068] and [0073]);

reading the template to determine whether the template contains one or more parameters representing incomplete information (Fig. 7, step s601 and related text), and subsequently acquiring data corresponding to the parameters by searching an installation database (Fig. 7, step s605 and related text), the installation database being located outside of said computer ("register property information at an installation server device", [0058]), wherein said searching is processed by said computer, based on said computer or a user of said computer ("driver information structure includes a PC name, ..., a user name, ...", [0052], FIG. 3 and related text), and wherein said acquiring data step includes a step of acquiring data regarding print setting information as data for said parameters from said installation database (see [0096]);

producing the scenario which is specific to said computer by incorporating the acquired data into the parameters of said template ("update the driver in accordance with the acquired property information ", [0073] and FIG. 7, step s607); and

inputting the produced scenario to an installation program (installation is inherent in updating of the driver which is saved, i.e. installed, including the added property information).

Claim 5:

Machida discloses a software-installing method for installing a plurality of items of software computers and simultaneously performing initial print setup in said computers,

so as to use a plurality of printing devices connected the computers through a network (see [0004] and [0012]), the method comprising the steps of:

producing a template of a scenario (driver setup information), the scenario being a file describing procedures for installing the software, the template including parameters, and providing said template to each of said computers (Fig. 19, steps s1902, s1903, and related text);

acquiring data corresponding to the parameters from an installation database (Fig. 19, step s1906 and related text) located outside said computers ("register property information at an installation server device , [0058]"), and wherein said data includes print setting information ([0095]); and

and producing scenarios, specific to each of said computers, based on the produced template (FIG. 19, step s1906); and

inputting the produced scenario to installation programs (FIG. 19, step s1907).

Claim 6:

Claim 6 is similar in scope and content to claim 4 and is rejected with the same rationale.

Claim 14:

Claim 14 is similar in scope and content to claim 4 and is rejected with the same rationale.

Claim 18:

Machida discloses a computer comprising:

a first producing element configured to produce a template of a scenario, the scenario being a file describing procedures for installing software, the template including parameters representing incomplete print setting information, and to provide said template to other computers (Fig. 19, step s1902 and related text); and

a second producing element configured to produce scenarios, specific to each of said computers, based on the produced template, by providing data for said parameters (Fig. 19, step s1906 and related text).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Neway whose telephone number is 571-270-1058. The examiner can normally be reached on Monday - Friday 8:30AM - 5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R Hudspeth can be reached on 571-272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. G. N./  
Examiner, Art Unit 2626

/David R Hudspeth/  
Supervisory Patent Examiner, Art Unit 2626